

REMARKS

The last Office Action has been carefully considered.

It is noted that the claims are rejected under 35 U.S.C. 103(a) over the patent to Sangyo in view of the patent to Shokai and further in view of the patent to Andreadakis.

Claim 27 is rejected over the patents to Sangyo, Shokai, Andreadakis and further in view of the patent to Frey.

Claim 23 is rejected under 35 U.S.C. 103(a) over the patent to Sangyo, Shokai, Andreadakis, in view of the patent to Kishimoto.

After carefully considering the Examiner's grounds for the rejection of the claims, applicant has canceled the original claims and submitted new claim 33, the broadest claim on file, and claim 34 which depends on it.

Before the analysis of the prior art, it is believed to be advisable to explain to the Examiner the new features of the present invention which

are now defined in claim 32. Claim 32 defines a method for formation of a panel of generating and diffusing heat, which includes the following new features:

- Warp of fiberglass;
- Weft of electrically conductive metal wire; coating of the pieces of fabric with an epoxy layer;
- making holes in the epoxy layer by a laser able to pass through the layer and the coating on the metal wire of the weft, but without in any way affecting the metal wire;
- providing connection of the ends of the metal wire of the weft to a source of electric current by the holes and wells;
- placing weft consisting of lengths of metal wires side-by-side, through which electrical current passes in order to eliminate harmful electric fields.

Turning now to the references, and in particular to the patent to Sangyo which is considered as a primary reference by the Examiner, it is respectfully submitted that this reference discloses a method for formation of a board with the weft F in fiberglass. In contrast, in the method of the applicant's invention as defined in claim 33 the warp is in fiberglass. It is

therefore believed to be clear that this reference does not teach the new features of the present invention which are now defined in claim 33.

The Examiner further indicated that the patent to Andreadakis teaches holes made by a laser in sheets of mica. In contrast, in the applicant's invention the wholes are made in the layer of epoxy material. Also, use is made of a laser by its nature suitable for passing through epoxy material, and the insulation coating of the metal wire of the weft, but without in anyway affecting the wire itself. Thus, the patent to Andreadakis also does not teach the new features of the present invention as now defined in claim 11.

The Examiner combined the teaching of the references and indicated that it would be obvious to arrive at the applicant's invention from such a combination. It is respectfully submitted that as explained herein above, the references did not disclose the new features of the present invention which are now defined in claim 33. Therefore, any hypothetical construction produced from such a combination would also not include new features of the present invention as defined in claim 33.

In order to arrive at the applicant's invention from the references, the references have to be fundamentally modified. In particular, they have to be modified by including into them the new features of the present invention which were first proposed by the applicant, while the references do not contain any hint or suggestion for such modifications. It is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not have any disclosure for the modifications proposed by the applicant.

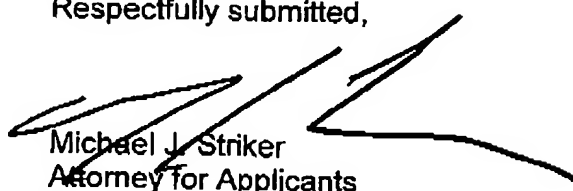
In view of the above presented remarks and amendments, it is believed that claim 33 should be considered as patentably distinguishing over the art and should be allowed.

Claim 34 also defines the features which are not disclosed in the references cited by the Examiner against the original claims. It is therefore believed that claim 34 should be considered as patentably distinguishing over the art not only because it depends on claim 33, but also because it contains the patentable subject matter per se.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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